REMARKS

This amendment responds to the Final Office Action mailed October 31, 2006. In the final office action the Examiner:

- rejected claims 1-3, 5-8, 10, 12-15, 17-20, 22, and 24-28 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- rejected claims 1-3, 5-8, 10, 12-15, 17-20, 22 and 24-28 as being indefinite under 35 U.S.C. § 112, second paragraph; and
- rejected claims 1-28 under 35 U.S.C. § 103(a) as being unpatentable over Cherkasova et al. (US 2002/0184448) in view of Takatori et al. (US 2002/0062323).

Independent claims 1, 2, 12, and 13 have been amended to address the Examiner's rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, to provide correct antecedent basis, and to further clarify the claimed invention. Claims 4-11 and 16-23 have been amended to correctly refer back to the independent claims. New claims 29-31 have been added. No new matter has been added.

Interview Summary

The Applicant's Representative spoke with Examiner Le by telephone on November 29, 2006 regarding the propriety of making the Office Action dated October 31, 2006 ("Office Action") final and asked for clarification of the claim rejections under 35 U.S.C. §101 and 35 U.S.C. §112, second paragraph ("non-prior art rejections") in the Office Action.

Applicant's position regarding the propriety of making the Office Action final is discussed more fully below. The Examiner did not agree to withdraw the finality of the Office Action, but did agree to consult the MPEP and revisit the issue in her next office action.

The Examiner explained that she had consulted the Interim Guidelines for Examination of Patent Applications for Patent Subject matter Eligibility and with a specialist in non-prior art issues and believed that the Amendment filed September 13, 2006 was insufficient to meet the new requirements. The Examiner also clarified that the non-prior art rejections could be overcome by amending the independent claims to include all of the

limitations in dependent claims 4, 9, and 11, or at the very least method steps and instructions for the cases where the search query is not stored in the cache. No agreement was reached on this issue; however, the Applicant has amended the independent claims consistently with dependent claims 4, 9, and 11 in order to expedite prosecution. The Applicant maintains the right to appeal the non-prior art rejections of the claims as previously submitted.

Request to Make Non-Final

The MPEP authoritatively describes the rules for examination of patent applications by the USPTO. In determining whether an Office Action may be made final, the MPEP requires that:

> "a second or any subsequent action on the merits in any application ... should not be made final if it includes **a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected** to be claimed. See MPEP §904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element." MPEP §706.07(a) (emphasis added).

Here, the Office Action cites Cherkasova and Takatori which have not previously been made of record, in rejecting all pending claims.

The amendments to the claims made in the Amendment of September 13, 2006 should have been reasonably expected. At the very least the amendment to claim 1 was made solely to overcome the Examiner's 35 U.S.C. §101 and §112, second paragraph rejections by providing for the return of a search report corresponding to the claimed search query under all conditions. The Office Action cites Cherkasova and Takatori as new art, to overcome all of the claim limitations. The fact that the claims have been amended to recite allegedly omitted steps is not sufficient to justify making the Office Action final because this amendment should reasonably have been expected in response to the Examiner's non-prior art rejections. Thus the finality of the Office Action should be withdrawn.

Independent claims 1, 2, 12 and 13 have been amended to overcome rejections under 35 § U.S.C. 101 and § 112, second paragraph

To expedite prosecution, claims 1 and 12 have been amended to recite "when the determining returns a negative result, generating a first search result in accordance with a first set of predetermined search criteria and returning as the search result at least a subset of the first search result" and "when the predefined conditions are not satisfied, returning as the search result at least a subset of the query result stored in the cache." Similarly, claims 2 and 13 have been amended to recite "when the determining returns a negative result, generating a first search result in accordance with a first set of predetermined search criteria and returning as the search result at least a subset of the first search result" and "when the reuse count is less than or equal to a predetermined threshold count or a quality indication does not meet predefined criteria, returning as the search result at least a subset of the query result stored in the cache." Support for these limitations can be found, *inter alia*, in original claims 4, 9, and 11. Thus, under all conditions, the claimed methods return a search report corresponding to the claimed search query. Thus, Claims 1, 2, 12, and 13 and all claims dependent thereon provide a practical result and include all essential steps required to provide this result, and therefore comply with 35 U.S.C. § 101 and § 112, paragraph two.

Cherkasova does not disclose generating an improved search result or accessing a reuse count of the search query

Cherkasova discloses a method for prioritizing documents in a web cache in order to provide an efficient cache replacement policy. See Abstract and paragraph 12. As stated in the Office Action, Cherkasova does not disclose generating an improved search result, which is not surprising since Cherkasova is directed toward caching rather than searching a document database.

The Office Action cites paragraph 62 of Cherkasova for describing accessing a reuse count for the search query. Paragraph 62 discloses increasing the value Fr(f) representing the frequency of access to a particular requested file in the cache. This value Fr(f) is not a count of the number of times a search query has been reused, but the number of times a particular file has actually been accessed. There is no disclosure in Cherkasova that every time a file is requested from the web cache it is accessed or even any correlation between requests for a file and access to a file. Instead, as is clear a requested file may not be in the web cache at all. See, e.g., paragraph 54. The claims have been amended to consistently refer to the reuse

count as the reuse count **of the search query** to emphasize that the reuse count refers to reuse of query. Thus, Cherkasova does not disclose all of the limitations of the claims.

Takatori does not disclose accessing a reuse count of the search query or generating an improved search result

Takatori discloses a method of searching a network and rearranging the results so the sites and/or pages are arranged in descending order of obtained access counter values. See Abstract. Takatori is not cited for and does not disclose accessing a reuse count of the query.

The claims, as amended recite "generating an improved search result in accordance with a second set of predetermined searching criteria including" "performing an additional search corresponding to the search query," or "using additional search resources." The Office Action cites paragraph 52 of Takatori for generating an improved search result in accordance with a first set of predefined searching criteria. Rearranging the sites and/or pages found in the search is neither generating an improved search result in accordance with a second set of search criteria, performing an additional search, nor using additional search resources. Takatori makes no disclosure of performing an additional search corresponding to the original search query. Instead, Takatori performs a single search and rearranges the sites and/or pages found in the search before outputting the result of that single search.

New claims 29-31 recite additional elements comprising generating an improved search result similar to those recited in claims 5-7. The Office Action cites paragraphs 59-65 and 72-77 of Takatori, without explanation, for searching both a standard database and an additional database. These portions of Takatori are also cited for searching the database to a larger search depth than the standard search depth or searching using modified search criteria to generate an improved search result. Applicant has reviewed these portions of Takatori and finds no mention of databases at all, much less teaching that generating an improved search result includes searching a database additional to the one required to generate the unimproved search result, searching a database to a larger search depth to the one required to generate the unimproved search result, or using search criteria distinct from the criteria required to generate the unimproved search result. In fact, no mention of databases or search criteria is made at all in Takatori.

Thus, Takatori does not disclose all of the limitations of the claims. Since neither Cherkasova nor Takatori, alone or in combination, disclose generating an improved search

result or accessing a reuse count of the search query, as required by all pending claims, the claims are patentable over Cherkasova in view of Takatori.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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/ Gary S. Williams / 31,066

Gary S. Williams (Reg. No.)

MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, CA 94306
(650) 843-4000